## REMARKS/ARGUMENTS

### I. General

Claims 1-14, 16-18, and 20-22 are pending in the current continued prosecution application. The issues raised in the Office Action mailed January 16, 2003 are:

- Claims 1-4, 6-10, 13-14, 16-18, and 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,108,492 to Miyachi (hereinafter "*Miyachi*") in view of Transact-SQL User's Guide (hereinafter "*SQL User's Guide*"); and

- Claims 5, 11, and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi* in view of *SQL User's Guide* and U.S. Patent Number 6,266,693 B1 to Onaga (hereinafter "*Onaga*").

### II. Response to Claim Rejections

The claims of the present application were rejected in the Office Action in the manner identified above. Applicants respectfully submit that the claims are allowable over the applied references of record, as described more fully below.

#### 35 U.S.C. § 103(a) Rejections over *Miyachi* in view of *SQL User's Guide*

Claims 1-4, 6-10, 13-14, 16-18, and 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi* in view of *SQL User's Guide*. In view of the comments below, Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See MPEP §2143. Without conceding any other criteria, Applicants respectfully assert that the rejection does not satisfy the first and third criteria, and therefore, the claims are not obvious under 35 U.S.C. § 103(a).

## 1. Applied Combination Fails to Teach All Claim Limitations

Applicants respectfully submit that *Miyachi* in view of *SQL User's Guide* fails to teach or suggest all the limitations of independent claims 1, 13, and 18.

Claim 1 recites in part:

> receiving a request from a client to notify said client of a condition of an attribute of a system, wherein said request comprises information specifying a query for said system attribute;

Claim 13 recites in part:

> computer executable software code for receiving from a client a request to notify said client of a condition of an attribute of a system, wherein said request comprises information specifying a query for said system attribute;

Claim 18 recites in part:

> wherein said reporting application includes computer executable software code for receiving from a client application program a request to notify said client application program of a condition of an attribute of a system, said request comprising information specifying a query for said system attribute...

Applicants respectfully submit that the combination of *Miyachi* and *SQL User's Guide* fails to teach or suggest at least the above limitations of independent claims 1, 13, and 18. Specifically, *Miyachi* in view of *SQL User's Guide* fails to teach or suggest receiving at a reporting application a request from a client, wherein the request includes information specifying a query for a system attribute.

The Examiner concedes that *Miyachi* does not disclose a request which comprises information specifying a query for said system attribute. However, the Examiner claims that Chapter 14 of the *SQL User's Guide* reference cures the *Miyachi* deficiency and further states:

> it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the *Miyachi* method by including the technique of defining a trigger condition by using SQL query as taught by *SQL User's Guide*, and by including the *SQL User's Guide* technique, a user-friendly system could be provided to the user by defining a trigger condition via either a SQL query or a pre-defined query. (Office Action, Page 4, lns 20-22 – Page 5, lns 1-2).

*Miyachi* teaches a data processing system that comprises a multi-function peripheral (MFP) and a Host, wherein the MFP periodically stores its status information and the Host periodically receives this status information and stores it in a database in the Host. Col. 3, lines 60-64 (Summary of the Invention). "A technician may select some or all of the information to be provided to the technician on the occurrence of a number of trigger conditions." Col. 3, lines 64-66 (Summary of the Invention). "The technician may set the trigger conditions from any of the reportable status conditions." Col. 3, line 66 - col. 4, line 1 (Summary of the Invention). A technician may select a number of the MFP status conditions to monitor (Col. 9, lines 40-42) and may also select a trigger condition to trigger notification of the technician. Col. 9, lines 55-59. *Miyachi* teaches a technique of selecting trigger conditions and fails to suggest that a user can form a query.

*SQL User's Guide*, Chapter 14 merely teaches methods of using SQL statements to create triggers, and *SQL User's Guide* combined with *Miyachi* does not teach the missing element of specifying a query for a system attribute. Chapter 14 of the *SQL User's Guide* describes a trigger as "a database object" that includes SQL statements that specify trigger conditions and trigger actions. The *SQL User's Guide* fails to teach that a technician, such as the technician of *Miyachi*, can create such a trigger within a query submitted to a reporting application. Even if such an SQL trigger were created in the database of *Miyachi* (without conceding this point), the *SQL User's Guide* fails to teach or suggest that it can be created by a query from a technician. rather, such SQL trigger would be created as "a database object", and, as described in *Miyachi*, the technician may be permitted to select such a trigger that is available in the database. Accordingly, while *Miyachi* teaches that trigger conditions may be available for selection by a technician and the *SQL User's Guide* teaches that SQL triggers may be created as database objects, neither *Miyachi* nor the *SQL User's Guide* teaches or suggests receiving a request from a client that includes information specifying a query for a system attribute. Thus, *Miyachi* in view of *SQL User's Guide* fails to teach or suggest "receiving a request from a client to notify said client of a condition of an attribute of a system, wherein said request comprises information specifying a query for said system attribute", as recited in claim 1. The applied combination also fails to teach or suggest the above limitations of independent claims 13 and 18.

As mentioned above, the Examiner relies on Chapter 14 of the *SQL User's Guide* reference as curing the acknowledged deficiency in *Miyachi*. Chapter 14 teaches a method of creating SQL triggers. In making the rejection, the Examiner asserts that "a *Miyachi* trigger condition indicates a pre-defined SQLs that comprises information specifying a query for said system attribute." Page 6 of Office Action.

Applicants respectfully assert that *Miyachi* does not define the trigger condition as one comprised of a pre-defined SQL, but *Miyachi* simply states that the technician is able to set the trigger to any reportable status condition. *Miyachi* makes no mention of SQL. Thus, the Examiner's assertion regarding the trigger condition of *Miyachi* indicating a pre-defined SQL is unsupported. As discussed below, the use of SQL is found in Applicants' disclosure, rather than within *Miyachi*.

Based on the arguments stated above, *Miyachi* in view of *SQL User's Guide* does not teach each and every element of independent claims 1, 13, and 18. Therefore, independent claims 1, 13, and 18 are not obvious over *Miyachi* in view of *SQL User's Guide*.

Additionally, Claim 13 recites:

computer executable code for querying said system as specified by said request......

Applicants respectfully submit that combined prior art *Miyachi* in view of *SQL User's Guide* fails to teach or suggest at least the above element of independent claim 13.

*Miyachi* states, "After the Host's processor 230 has generated a signal to the MFP's processor 235 to request the current status information, the Host's processor 230 uses this status information to update the Host's MFP status database stored in data storage device 240." The *Miyachi* reference also states, "if the process is to continue, the processor 230 analyzes the status information database (step 455) and determines if any of the trigger conditions have been met. (step 460)." Col. 10, lines 44-55. As such, *Miyachi* teaches analyzing the status information database to determine if any trigger conditions have been met. The Host requests an update of status information from the MFP, stores that information into the status information database, and then periodically checks the status information database to determine if a trigger has been met. Thus, to the extent that a trigger condition is selected in *Miyachi*, the status information database is analyzed for such trigger

condition, rather than the system being queried as specified by a received request. For instance, *Miyachi* teaches that, irrespective of a selected trigger condition (or any other received request), an MFP collects certain status information. A Host requests the collected status information and stores it to a database, and such database may be analyzed to determine whether a selected trigger condition is satisfied. Thus, the system is not queried as specified by a received request, but rather the MFP collects certain status information irrespective of any request that may be received. Further, an analysis of the database (e.g., to determine whether a trigger condition is satisfied) is necessarily limited to the information collected by the MFP. A technician is not able to submit a request specifying a query of the system, but can instead only select trigger conditions for information that is collected in the Host's database. If, for example, the technician desires to be notified about a condition of a system attribute that is not reported by the MFP, the system of *Miyachi* does not permit the technician to select a trigger condition for such an attribute (as it is not included in the Host's database).

*SQL User's Guide* teaches the use of SQL commands and does not cure the above deficiency. Therefore, the applied combination does not teach each and every element of independent claim 13.

## 2. Improper Motivation to Combine References

It is well settled that sufficient motivation must be provided to establish a prima facie case of obviousness. See M.P.E.P. § 2143. In the Examiner's arguments, there is improper motivation to combine the cited references for the reasons stated below.

### Impermissible Hindsight

Applicants respectfully assert that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants' disclosure, see M.P.E.P. § 2145(X)(A). The motivation supplied in the Office Action is derived from the Applicant's disclosure, see page 7, lines 20-24. The teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. See M.P.E.P. §2143, citing In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

*Miyachi* does not teach or suggest the use of receiving a query from a client, it simply

states that a technician is able to set a trigger condition to any reportable status condition. Furthermore, *Miyachi* does not teach or suggest that the trigger selected by a technician is an SQL trigger. Moreover, *Miyachi* makes no mention of the use of an SQL query. Rather, the notion of using an SQL query is derived by the Examiner from Applicants' disclosure. Based on the use of this hindsight, the Examiner then claims it would be obvious to combine the teachings of *Miyachi* with the *SQL User's Guide* in order to render the pending claims obvious. In doing this, the Examiner is using improper hindsight. Thus, the motivation to combine provided by the Examiner is improper, as the motivation must be described in a prior art reference and must detail the benefits of such a combination. As such, the combination of the cited references is improper, and therefore, the rejected claims are not obvious under 35 U.S.C. § 103(a).

### Applied Combination Would Impermissibly Change a Principle of Operation of the Primary Reference

Applicants respectfully assert that the applied combination impermissibly changes operation of *Miyachi*. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious, M.P.E.P. § 2143.01, citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959).

*Miyachi* teaches that a technician is allowed to select a trigger condition based on any number of reportable status conditions. *Miyachi* does not place limitations upon the scope of requirements for being a technician and the technician's ability to select a trigger condition from any of the reportable status conditions. The Examiner asserts that Chapter 14 of *SQL User's Guide* in combination with *Miyachi* renders the pending claims obvious. Chapter 14 of the *SQL User's Guide* provides instructions on creating triggers using SQL statements. Additionally, Chapter 14 provides that, "no one except the table owner can create a trigger on a table." (*SQL User's Guide*, Chapter 14, page 2, ln 2). As such, this requirement would place a restriction on *Miyachi* that would limit its applicability in that only a technician that is the owner of the table is permitted to create a trigger. *Miyachi* fails to teach or suggest any such limitation requiring the technician to be the owner of a table. Therefore, the combination of *SQL User's Guide* with *Miyachi* would change the principle of operation of

*Miyachi*, and as such, the suggested combination of teachings of the references are not sufficient to render the claims prima face obvious, M.P.E.P. § 2143.01, citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959).

Additionally, the Examiner's proposed modification to *Miyachi*, which would require a technician to be the owner of a table, would render *Miyachi* unsatisfactory for its intended purpose. As such, M.P.E.P. § 2143.01 provides that in establishing obviousness under 35 U.S.C. § 103(a), the proposed modification to the prior art cannot render the prior art unsatisfactory for its intended purpose. As such, the proposed modifications are not sufficient to render the pending claims prima facie obvious.

### Claims 2-12, 14, 16-17, and 20-22

In view of the above, Applicants submit that independent claims 1, 13, and 18 are allowable over the applied combination. Further, dependent claims 2-12, 14, 16-17, and 20-22 each depend either directly or indirectly from one of independent claims 1, 13, and 18 and thus inherit all of the limitations of their respective independent claims. It is respectfully submitted that dependent claims 2-12, 14, 16-17, and 20-22 are allowable not only because of their dependencies from their respective independent claims 1, 13, and 18 for the reasons discussed above, but also in view of their novel claim features which narrow the scope of the particular claims and compel a broader interpretation of the independent claims from which they depend.

### 35 U.S.C. § 103(a) Rejections over *Miyachi* in view of *SQL User's Guide* and *Onaga*

Claims 5, 11, and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi* in view of *SQL User's Guide* and *Onaga*. Dependent claims 5, 11, and 12 depend from independent claim 1 and therefore inherit all of its limitations. *Onaga* does not cure the deficiencies discussed above, and as such, claims 5, 11, and 12 are allowable based on the arguments stated above.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this
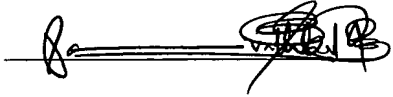
application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10990763-2 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV255977082US, in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on the date shown below.

Date of Deposit: April 16, 2003

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